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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 16

Application Number: 09/418,509
Filing Date: October 15, 1999
Appellant(s): ROCHON ET AL.

Richard A. Neifeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on November 01, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because, on page 2 and second paragraph, Appellant wrote "The invention comprises a system and method that depend transmitting a manufacturer's sample offer for a product sample to a user..." which is unclear. It appears that the Appellant meant to write -- The invention comprises a system and method that depend **on** transmitting a manufacturer's sample offer for a product sample to a user...--.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: **The Examiner, upon consulting his primary Examiner, has decided to**

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withdraw the rejections of claims 31, 34 and 37 under 35 USC 101 and 35 USC 112, First paragraph.

(7) *Grouping of Claims*

The rejection of claims 1-37 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The Examiner objects to the groupings of the claims in conjunction with the rejection under 35 USC 102 because of the following reasons-

First, it appears that there is some inconsistency between the **Grouping of the Claims** as set forth in group 1 (page 2) comprising claims 1 and 16 and the **Rejection of Group 1 under 35 USC 102** as set forth in paragraph (a) on page 6, wherein the Appellant also incorporates claim 31, which clearly belongs to group 14 (page 4). The Examiner will address claims 1 and 16 and 31 separately as set forth in groups 1 and 14.

Second, although Appellant clearly pointed out on page 4 that claim 34 belongs to group 16, Appellant failed to explicitly mention claim 34 in the discussion of the rejection under 35 USC 102 of Groups **15 and 16**, which only referred to claims 32 and 33.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO 97/23838

Scroggie et al

07-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-37 are rejected under 35 U.S.C. 102. This rejection is set forth in prior Office Action (Paper No. 13) and incorporated herein.

Claims 1-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al, WO 97/23838.

As per claims 1-15, 32 and 35, Scroggie et al teach a method comprising the steps of:

1.

Transmitting a signal **via Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer or a **Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address or **IP address** for the user's computer **302 of fig.13** (See abstract-page 2 lines 1-7 and page 10 lines 5-17);

Transmitting a manufacturer's sample offer **154 of fig.5 (page 12 lines 11-26 and page 13 lines 2-5)** or other variety of offers stored in storage device or **Hard Disk 306 of fig.13** by **manufacturers**, from said main computer or **Server 300** of fig.13 over said computer network

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or Internet 304 of fig.13 to said network address or **IP address** for said user's computer **302 of fig.13** (page 18 line 20 to page 19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (page 4 lines 3-10 and page 21 lines 4-21) of a product; and

Generating instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer **or Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and page 19 line 15 to page 20 line 8).

2.The method further comprising the step of:

Determining, **upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5**, if said user's profile data **or demographic data** meet said user profile criteria associated with said manufacturer's sample offer **or other variety of offers** for a sample of said product (page 21 lines 14-21).

3. The method further comprising the step of:

Determining if said main computer **or Web Server or Web Site 508 of fig.15** receives, **subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520 such a product sample 154**, said signal **or response** transmitted over said computer network **or Internet 304** indicating said user accepts said manufacturer's sample offer **or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the**

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manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p.19 lines 15-25).

4. (Amended) The method further comprising the step of:

Determining, **upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable**, if said user purchases a product for which said instructions for providing said sample of said product are generated (Anticipated in the art- p.19 lines 15-25).

5. Wherein said transmitting said manufacturer's sample offer comprises the step of:

Storing said profile data in a consumer database 506 of fig.15.

6. The method further comprising the step of:

Transmitting a solicitation for feedback, **by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration**, regarding said product from said main computer **or Server or Web Site** over said computer network **or Internet 304** to said network address or **IP address** for said user's computer 510 (Anticipated in the art).

7. Wherein said step of transmitting a signal comprises:

Transmitting a signal prompting said user to provide said user's postal mailing address (p.14 line 24 to p.15 line 2).

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8. The method further comprising the step of:

Transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig.5.** (P.12 line 29 to p.13 line 5).

9. The method further comprising the step of:

Mailing a coupon discounting a full price of said sample, **or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al),** to a postal mailing address of said user (p.1 lines 10-12).

10. The method further comprising the step of:

Mailing said sample to a postal address for said user (see abstract and p.12 line 25).

11. Wherein said step of delivering comprises:

Transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al),** for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples **depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).**

12. Wherein said step of transmitting said manufacturer's sample offer comprises the step of:

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Sending e-mail, **which contains a token attachment** over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15).

13. The method further comprising the step of:

Storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502,** (p.20 lines 17-24).

14. The method further comprising the step of:

Determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable** (p.19 lines 15-25).

15. The method further comprising the step of:

Transmitting said manufacturer's sample **154 offer or Weekly offers 520 from Manufacturers 518** from said main computer **or Web Site 508 or Server 300** over said computer network **or Internet 304** to said network address **or IP address** for said user's computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

32. (New) Wherein said step of transmitting a manufacturer's sample offer for a sample 154 of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product (clearly anticipated by Scroggie et al).

35. (New) Wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p. 12 lines 11-26 and p.13 lines 2-5).

As per claims 16-30, 33 and 36, Scroggie et al disclose a system comprising:

16. (Amended) A computer network system, comprising:

A main computer (300) of fig.13 or (508) of fig.15, said main computer configured:

To transmit a signal **via Log-in Page 16 of fig.1** prompting a user 10 to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-p.2 lines 1-7 and p.10 lines 5-17);

To transmit a manufacturer's sample offer **154 of fig.5 (p. 12 lines 11-26 and p.13 lines 2-5) or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by manufacturers**, from said main computer **or Server 300** of fig.13 over said computer network

or Internet 304 of fig.13 to said network address or **IP address** for said user's computer **302 of fig.13** (p.18 line 24 to p.19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (p.4 lines 3-10 and p.21 lines 4-21) of a product; and

To generate instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer **or Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and p.19 line 15 to p.20 line 8)

17. The system further comprising;

Means **such an anticipated comparator** for determining, **upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5**, if said user's profile data **or demographic data** meet said user profile criteria associated with said manufacturer's sample offer **or other variety of offers** for a sample of said product (p.21 lines 14-21).

18. The system further comprising;

Means for determining if said main computer **or Web Server or Web Site 508 of fig.15** receives, **subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520 such a product sample 154**, said signal **or response** transmitted over said computer network **or Internet 304** indicating said user accepts said manufacturer's sample offer **or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154**

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from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15-p.20 lines 2-14).

19. (Amended) The system of claim 16, further comprising:

Means for determining, **upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable**, if said user purchases a product for which said main computer 300 or 508 is configured to generate instructions for providing said sample of said product (Anticipated by Scroggie et al- p.19 lines 15-25).

20. The system further comprising:

A consumer database 506 of fig.15 for storing said profile data.

21. The system further comprising:

Means **such as communication tools** for transmitting a solicitation for feedback, **by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration**, regarding said product from said main computer or Server or Web Site over said computer network **or Internet 304** to said network address or **IP address** for said user's computer 510 (Anticipated by Scroggie).

22. (Amended) The system further comprising:

Means **as described in figs. 1 and 2** for transmitting a signal prompting said user to provide said user's postal mailing address (p.14 line 24 to p.15 line 2).

23. The system further comprising:

Means **as described in fig. 5** for transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig.5** (p.12 line 29 to p.13 line 5) **for further processing.**

24. The system further comprising:

Means for mailing a coupon for a free one of said samples, **or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, to a postal mailing address of said user (p.1 lines 10-12).

25. The system further comprising:

Means for mailing said sample to a postal address for said user **via well established Post Office, UPS and so on** (see abstract and p.12 line 25). .

26. The system further comprising:

Means **such as communication tools** for transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, for the full price of said

sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples **depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).**

27. The system further comprising:

Means for sending e-mail, **which contains a token attachment** over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15).

28. The system further comprising:

Means **or storage medium or Hard Disk** for storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502,** (p.20 lines 17-24).

29. (Amended) The system further comprising:

Means for determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable payment instrument (p.19 lines 15-25).**

30. (Amended) The system further comprising:

Means for transmitting said manufacturer's sample **154** offer or **Weekly offers 520** from **Manufacturers 518** from said main computer or **Web Site 508** or **Server 300** over said computer network or **Internet 304** to said network address or **IP address** for said user's computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product or **any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

33. (New) Wherein said main computer 300 or 508 is configured to transmit a manufacturer's sample offer for a sample 154 of a packaged good product (Clearly anticipated by Scroggie et al).

36. (New) Wherein said main computer 300 or 508 is configured to generate instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p.13 lines 2-5).

As per claims 31, 34 and 37, Scroggie et al teach -

A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as anticipated by Scroggie et al:

Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

(11) *Response to Argument*

The Examiner will address the issues raised by the Appellant in the order in which they appear in the appeal brief.

37 CFR 1.192(c)(8)(iii) Rejections under 35 USC 102

The examiner stated that claims 1-37 were rejected under 35 USC 102(b) based upon WO 97/23838.' In reply, applicant asserts that the WO 97/23838 publication does not anticipate the claims in the Rochon application.

a. Group 1

The WO 97/23838 publication does not disclose or suggest depending the transmission of a manufacturer's product sample offer to the user upon whether the user's profile data meet user

profile criteria associated with the manufacturer's product sample offer. In contrast, independent claims **1 and 16**, define that limitation. Therefore, the rejections of all claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 1, 16, Scroggie et al disclose the following limitations-

1.

Transmitting a signal **via Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-page 2 lines 1-7 and page 10 lines 5-17);

Transmitting a manufacturer's sample offer **154 of fig.5 (page 12 lines 11-26 and page 13 lines 2-5) or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by manufacturers**, from said main computer **or Server 300** of fig.13 over said computer network **or Internet 304 of fig.13** to said network address **or IP address** for said user's computer **302 of fig.13** (page 18 line 20 to page 19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5 (page 4 lines 3-10 and page 21 lines 4-21)** of a product; and

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Generating instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer **or Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and page 19 line 15 to page 20 line 8).

16. (Amended) A computer network system, comprising:

A main computer (300) of fig.13 or (508) of fig.15, said main computer configured:

To transmit a signal **via Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-p.2 lines 1-7 and p.10 lines 5-17);

To transmit a manufacturer's sample offer **154 of fig.5** (p. 12 lines 11-26 and p.13 lines 2-5) **or other variety of offers stored in storage device or Hard Disk 306 of fig.13** by **manufacturers**, from said main computer **or Server 300** of fig.13 over said computer network **or Internet 304 of fig.13** to said network address **or IP address** for said user's computer **302 of fig.13** (p.18 line 24 to p.19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (p.4 lines 3-10 and p.21 lines 4-21) of a product; and

To generate instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer **or Server 300 of fig.13** receives a

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signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and p.19 line 15 to p.20 line 8)

b. Group 2

The WO 97/23838 publication does not disclose or suggest a method or system for determining if the user's profile data meet the user profile criteria associated with the manufacturer's sample offer for a sample of the product. In contrast, claims 2 and 17 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 2 and 17, Scroggie et al disclose the following limitations-

2.The method further comprising the step of:

Determining, **upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5**, if said user's profile data **or demographic data** meet said user profile criteria associated with said manufacturer's sample offer **or other variety of offers** for a sample of said product (page 21 lines 14-21).

17. The system further comprising;

Means **such an anticipated comparator** for determining, **upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5**, if said user's profile data **or demographic data** meet said user profile criteria associated with said manufacturer's sample offer **or other variety of offers** for a sample of said product (p.21 lines 14-21).

c. Group 3

The WO 97/23838 publication does not disclose or suggest a method or system for determining whether the main computer receives a signal indicating that the user accepts the manufacturer's sample offer. In contrast, claims 3 and 18 define that limitation. Therefore, the rejection of this group of claims should be reversed.

'See Final Office Action dated 8/13/01, page 2. 6

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 3 and 18, Scroggie et al disclose the following limitations-

3. The method further comprising the step of:

Determining if said main computer **or Web Server or Web Site 508 of fig.15** receives, **subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520**

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such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p.19 lines 15-25).

18. The system further comprising;

Means for determining if said main computer or Web Server or Web Site 508 of fig.15 receives, subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520 **such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p. 20 lines 2-14).**

d. Group 4

The WO 97/23838 publication does not disclose or suggest a method or system for determining whether the user buys the product for which instructions for receiving a sample offer have been generated. In contrast, claims 4 and 19 define that limitation. Therefore, the rejection of this group of claims should be reversed.

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However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 4 and 19, Scroggie et al disclose the following limitations-

4. (Amended) The method further comprising the step of:

Determining, **upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable**, if said user purchases a product for which said instructions for providing said sample of said product are generated (Anticipated in the art- p.19 lines 15-25).

19. (Amended) The system of claim 16, further comprising:

Means for determining, **upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable**, if said user purchases a product for which said main computer 300 or 508 is configured to generate instructions for providing said sample of said product (Anticipated by Scroggie et al- p.19 lines 15-25).

e. Group 5

The WO 97/23838 publication does not disclose or suggest a method or system for storing profile data in a consumer database. In contrast, claims 5 and 20 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 5 and 20, Scroggie et al disclose the following limitations-

5. Wherein said transmitting said manufacturer's sample offer comprises the step of:
Storing said profile data in a consumer database 506 of fig.15.

20. The system further comprising:

A consumer database 506 of fig.15 for storing said profile data.

f. Group 6

The WO 97/23838 publication does not disclose or suggest a method or system for soliciting feedback regarding the product. In contrast, claims 6 and 21 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 6 and 21, Scroggie et al disclose the following limitations-

6. The method further comprising the step of:

Transmitting a solicitation for feedback, **by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration**, regarding said product from said main computer **or Server or Web Site** over said computer network **or Internet 304** to said network address or **IP address** for said user's computer 510 (Anticipated in the art).

21. The system further comprising:

Means **such as communication tools** for transmitting a solicitation for feedback, **by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration**, regarding said product from said main computer **or Server or Web Site** over said computer network **or Internet 304** to said network address or **IP address** for said user's computer 510 (Anticipated by Scroggie).

Concerning claims 6 and 21, Scroggie et al further disclose, among other things, a method and system for distributing purchase incentives over a network including manufacturers' samples 154 of fig. 5 to qualified and registered users or consumers 10 based on their demographic profile, such as zip code, IP addresses and purchase history (figs. 1, 2, 3, 5, 9 and 15; page 13: 2-3; page 1: 27 to page 7: 6). It should further be understood that a vendor, retailer or business or manufacturer could effectively promote its products by distributing free product samples 154 to qualified and registered users or consumers 10 of fig. 5 over the Internet 304. Upon redeeming or picking up the free samples at particular stores, previously selected by the consumers, if they were directly mailed to the consumers' mailing addresses (page 12: 25; page

18: 21 to page 19: 12), redemption data will be forwarded by the stores to Fulfillment House 158 of fig. 5 for further processing. The primary objective of distributing free samples to qualified consumers by the manufacturers is to promote their products and collect marketing data including consumers' feedback after they used the free samples, as understood in the art of marketing. In the end, the manufacturers want, by distributing product samples to qualified consumers, to entice or encourage these consumers to purchase the products associated with the product samples or free samples and use the information collected from the consumers' purchases, especially if the consumers have to register the purchased products with the manufacturers, not only to further prepare targeted purchase incentives for those qualified consumers, but also to measure the effectiveness of the distribution of the free samples by determining if a consumer who received a free sample or product sample had subsequently purchased the product related to the sample. This is a well-established business practice in the industry, very popular among software distributors, and well anticipated in any targeted sample distribution promotion.

Therefore, these limitations of the claimed invention are anticipated by Scroggie et al who disclose a method and system for distributing targeted product samples 154 of fig. 5 over the Internet to qualified consumers 10 of fig. 1.

g. Group 7

The WO 97/23838 publication does not disclose or suggest a method or system for prompting the user to provide the user's postal mailing address. In contrast, claims 7 and 22 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 7 and 22, Scroggie et al disclose the following limitations-

7. Wherein said step of transmitting a signal comprises:

Transmitting a signal prompting said user to provide said user's postal mailing address (p.14 line 24 to p.15 line 2).

22. (Amended) The system further comprising:

Means **as described in figs. 1 and 2** for transmitting a signal prompting said user to provide said user's postal mailing address (p.14 line 24 to p.15 line 2).

h. Group 8

The WO 97/23838 publication does not disclose or suggest a method or system for transmitting the user's postal mailing address from the main computer to the network address for a third party. In contrast, claims 8 and 23 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 8 and 23, Scroggie et al disclose the following limitations-

8. The method further comprising the step of:

Transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig.5.** (P.12 line 29 to p.13 line 5).

23. The system further comprising:

Means **as described in fig. 5** for transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig.5** (p.12 line 29 to p.13 line 5) **for further processing.**

i. Group 9

The WO 97/23838 publication does not disclose or suggest a method or system for mailing the user a coupon discounting the full price of the sample to the postal mailing address of the user. In contrast, claims 9 and 24 define that limitation. Therefore, the rejection of this group of claims should be reversed.

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However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 9 and 24, Scroggie et al disclose the following limitations-

9. The method further comprising the step of:

Mailing a coupon discounting a full price of said sample, **or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, to a postal mailing address of said user (p.1 lines 10-12).

24. The system further comprising:

Means for mailing a coupon for a free one of said samples, **or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, to a postal mailing address of said user (p.1 lines 10-12).

j. Group 10

The WO 97/23838 publication does not disclose or suggest a method or system for mailing the sample to the user. In contrast, claims 10 and 25 define that limitation. Therefore, the rejection of this group of claims should be reversed.

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However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 10 and 25, Scroggie et al disclose the following limitations-

10. The method further comprising the step of:

Mailing said sample to a postal address for said user (see abstract and p.12 line 25).

25. The system further comprising:

Means for mailing said sample to a postal address for said user **via well established Post Office, UPS and so on** (see abstract and p.12 line 25).

k. Group 11

The WO 97/23838 publication does not disclose or suggest a method or system for transmitting an electronic discount or coupon to a point of sale terminal for the full price of the sample if the main computer indicates that the user accepts the manufacturer's offer. In contrast, claims 11 and 26 define that limitation. Therefore the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 11 and 26, Scroggie et al disclose the following limitations-

11. Wherein said step of delivering comprises:

Transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al),** for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples **depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).**

26. The system further comprising:

Means **such as communication tools** for transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al),** for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples **depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).**

1. Group 12

The WO 97/23838 publication does not disclose or suggest a method or system for sending email over the computer network to the user. In contrast, claims 12 and 27 define that limitation. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 12 and 27, Scroggie et al disclose the following limitations-

12. Wherein said step of transmitting said manufacturer's sample offer comprises the step of:
Sending e-mail, **which contains a token attachment** over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15).

27. The system further comprising:

Means for sending e-mail, **which contains a token attachment** over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15).

m. **Group 13**

The WO 97/23838 publication does not disclose or suggest a method or system for storing a user's profile and purchase data with a unique identifier in a consumer database. In contrast, claims 13 and 28 define that limitation. Nor does the publication disclose or suggest using the method or system of claims 13 and 28 to determine consumer conversion based at least

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in part on purchase information stored in the consumer database. In contrast, claims 14 and 29 further define that limitation.

Finally, the publication does not disclose or suggest using the method or system of claims 13 and 28 to depend on the transmission of the manufacturer's sample offer based on user profile criteria and purchase history stored in the consumer database. In contrast, claims 15 and 30 further define that limitation.

Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 13, 14, 15, 28, 29 and 30, Scroggie et al disclose the following limitations-

13. The method further comprising the step of:

Storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502**, (p.20 lines 17-24).

28. The system further comprising:

Means or storage medium or Hard Disk for storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user

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in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502**, (p.20 lines 17-24).

14. The method further comprising the step of:

Determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable payment instrument** (p.19 lines 15-25).

29. (Amended) The system further comprising:

Means for determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable payment instrument** (p.19 lines 15-25).

Concerning claims 14 and 29, Scroggie et al further disclose, among other things, a method and system for distributing purchase incentives over a network including manufacturers' samples 154 of fig. 5 to qualified and registered users or consumers 10 based on their demographic profile, such as zip code, IP addresses and purchase history (figs. 1, 2, 3, 5, 9 and 15; page 13: 2-3; page 1: 27 to page 7: 6). It should further be understood that a vendor, retailer

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or business or manufacturer could effectively promote its products by distributing free product samples 154 to qualified and registered users or consumers 10 of fig. 5 over the Internet 304. Upon redeeming or picking up the free samples at particular stores, previously selected by the consumers, if they were directly mailed to the consumers' mailing addresses (page 12: 25; page 18: 21 to page 19: 12), redemption data will be forwarded by the stores to Fulfillment House 158 of fig. 5 for further processing. The primary objective of distributing free samples to qualified consumers by the manufacturers is to promote their products and collect marketing data including consumers' feedback after they used the free samples, as understood in the art of marketing. In the end, the manufacturers want, by distributing product samples to qualified consumers, to entice or encourage these consumers to purchase the products associated with the product samples or free samples and use the information collected from the consumers' purchases, especially if the consumers have to register the purchased products with the manufacturers, not only to further prepare targeted purchase incentives for those qualified consumers, but also to measure the effectiveness of the distribution of the free samples by determining if a consumer who received a free sample or product sample had subsequently purchased the product related to the sample (conversion factor). This is a well-established business practice in the industry, very popular among software distributors, and well anticipated in any targeted sample distribution promotion.

Therefore, these limitations of the claimed invention are anticipated by Scroggie et al who disclose a method and system for distributing targeted product samples 154 of fig. 5 over the Internet to qualified consumers 10 of fig. 1.

15. The method further comprising the step of:

Transmitting said manufacturer's sample **154** offer **or Weekly offers 520** from **Manufacturers 518** from said main computer **or Web Site 508** **or Server 300** over said computer network **or Internet 304** to said network address **or IP address** for said user's computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

30. (Amended) The system further comprising:

Means for transmitting said manufacturer's sample **154** offer **or Weekly offers 520** from **Manufacturers 518** from said main computer **or Web Site 508** **or Server 300** over said computer network **or Internet 304** to said network address **or IP address** for said user's computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

n. Group 14

The WO 97/23838 publication does not disclose or suggest a product wherein the program transmits the manufacturer's sample offer (if user profile data meets user profile criteria associated with the manufacturer's sample offer for a sample of the product). In contrast, claim 31 defines this limitation. Therefore, the rejection of this group of one claim should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claim 31, Scroggie et al disclose the following limitations-

31. A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as anticipated by Scroggie et al:

Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

Claim 31 contains limitations already addressed in claim 1 and therefore, these limitations of claim 31 can be rejected under a similar rationale.

o. Groups 15 and 16

The WO 97/23838 publication does not disclose or suggest a method for transmitting a manufacturer's sample offer for a sample of a packaged good product. In contrast, claims 32 and 33 define these limitations. Therefore, the rejection of this group of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 32-33, Scroggie et al disclose the following limitations-

32. (New) Wherein said step of transmitting a manufacturer's sample offer for a sample 154 of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product (clearly anticipated by Scroggie et al).

33. (New) Wherein said main computer 300 or 508 is configured to transmit a manufacturer's sample offer for a sample 154 of a packaged good product (Clearly anticipated by Scroggie et al).

p. Groups 17 and 18

The WO 97/23838 publication does not disclose or suggest a system wherein the main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged

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good product and to generate instructions for packing and shipping that sample to the user. In contrast, claims 35-37 define these limitations. Therefore, the rejection of these groups of claims should be reversed.

However, the Examiner respectfully disagrees with the Appellant's findings. Indeed, these limitations, as shown below, are either inherent or anticipated in the art or clearly addressed by Scroggie et al-

As per claims 35-37, Scroggie et al disclose the following limitations-

35. (New) Wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p. 12 lines 11-26 and p.13 lines 2-5).

36. (New) Wherein said main computer 300 or 508 is configured to generate instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p.13 lines 2-5).

37. A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as anticipated by Scroggie et al:

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Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

For the above reasons, it is believed that the rejections should be sustained.

JDJ

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conference

Respectfully submitted,

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